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[10191/1773]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Thomas MUELLER et al.

For: DEVICE FOR PLAYING BACK
MULTIMEDIA DATA FILES FROM
A STORAGE DEVICE IN AN
AUTOMOTIVE SOUND SYSTEM

Filed: March 23, 2001

Serial No.: 09/816,526

Examiner: Xu Mei

Art Unit: 2615

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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Signature:

AARON C. DEDITCH
REPLY BRIEF TRANSMITTAL
(33,865)

SIR:

Accompanying this Reply Brief Transmittal is a Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-identified patent application, together with two courtesy copies thereof (although not required). The two-month response date is March 3, 2008 to the Answer dated January 2, 2008 ("the Answer") (the two-month reply brief due date is March 3, 2008 (since March 2, 2008 was a Sunday)).

While no fee is believed to be due, the Commissioner is authorized to charge, as necessary and/or appropriate, any additional and appropriate fees (including any extension fees) or credit any overpayment to Deposit Account No. 11-0600. A duplicate copy of this transmittal letter is enclosed for that purpose.

Respectfully submitted,

Dated: 2/28/2008

By: Gerard A. Messina

Gerard A. Messina
(Reg. No. 35,942)
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646

33,865

Aaron C. DEDITCH

U.S. Pat. App. Ser. No. 09/816,526
Attorney Docket No. 10191/1773
Reply Brief



[10191/1773]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPEAL BRIEF PATENTS
2/28/2008

AARON C. DEDITCH
(33,865)

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.37

SIR:

In the above-identified patent application ("the present application"), an Answer issued on January 2, 2008, so that the two-month reply brief due date is March 3, 2008 (since March 2, 2008 is a Sunday). The Appeal Brief was filed October 1, 2007 (and mailed on September 27, 2007). This Reply Brief is being filed by the two-month response date.

Although not required, two duplicate copies of this Reply Brief are also being submitted herewith as a courtesy to the Patent Office.

For the reasons explained in the Appeal Brief and those explained below, it is again respectfully submitted that the final rejections of claims 2 to 17 should be reversed for the reasons explained below, so that these claims may be allowed.

REPLY

**A. The Rejections Under 35 U.S.C. § 103(a) That Claims 2 to 17
Are Obvious Over Lee In View Of Lau**

Claims 2 to 17

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Regarding the Answer (as well as the Office Actions to date), the Office maintains the rejections of the claims based on Lee in view of the Lau reference. It refers to column 5, lines 17 to 28, column 6, lines 17 to 62, column 8, lines 17 to 32 and lines 47 to 67 of Lau, as assertedly disclosing that a processor includes an element for displaying directories located in

the storage device and in which the multimedia data files are contained, as different virtual data carriers as recited in claim 17 (see Answer, page 4, lines 1 to 9)¹. Moreover, the Answer conclusorily asserts that independent claims 17, 2, 5 and 9 provide no written interpretation, description or explanation in regard what is being considered as “different virtual data carriers”, and therefore, the claimed feature “different virtual data carriers” can be interpreted as “a different way of naming an element for displaying directories” (see id., page 10, lines 6 to 10). It is also conclusorily asserted that the motivation for the combination of Lee and Lau would have been considered in the knowledge generally available to one of ordinary skill in the art.

Claim 17 (and claims 2, 5 and 9) relates to a device for playing back multimedia files stored in an automotive environment, which includes a storage device and a processor for decoding the multimedia files. Claim 17 (and claims 2, 5 and 9) further provides that the processor includes an element for ***displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers***, that multimedia data files as different titles on the display, and that the different data virtual carriers and the different titles are selectable in accordance with an operation of the input apparatus.

With respect to the assertion that the combination of Lee and Lau renders claim 17 (and claims 2, 5, and 9) obvious, it is respectfully submitted that Lee and Lau, whether taken alone or combined, do not disclose the feature of ***displaying directories located in the storage device and in which the multimedia data files are contained, as different virtual data carriers***, as provided for in the context of claim 17 (and claims 2, 5, and 9). The Lee reference merely concerns a MP3 car player -- which, as essentially admitted in the Answer -- does not disclose or suggest the claim feature of displaying directories located in the storage device, as provided for in the context of the claimed subject matter. The Answer also asserts that Lau describes “a vehicle sound system which includes the storage of MP3 files to the music server and/or head unit (including a display) of the within a vehicle and/or internet music files into a computer, where in the multimedia files are stored in level of directories

¹ The Answer expressly admitted that Lee fails to specifically disclose the processor including an element for displaying directories located in the storage device (see id., page 3, lines 19 to 22).

and obviously displayed,” which assertedly discloses the feature of an element for displaying directories located in the storage device (see Answer, page 4, lines 1 to 5). It is respectfully submitted that Lau simply does not disclose the feature of ***displaying directories in the storage device and in which the multimedia data files are contained, as different virtual data carriers***, as provided for in the context of the claimed subject matter. A mere conclusory statement, such as the statement that “the multimedia files are stored in level of directories and *obviously* displayed” in the Answer -- without any proper substantiation -- cannot support the assertion as to any disclosure by the Lau reference.

The Office must demonstrate prior teaching or suggestion of all of the claim features to meet its initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d at 1532; see also In re Royka, 490 F.2d 198. Indeed, it is believed and respectfully submitted that any examination of Lau makes plain that even if it may concern a display screen including a play list, (see Lau, column 19, lines 26 to 32), it simply does not disclose the feature of displaying directories. This is because a play list in Lau is plainly referred to as a file stored in the directory of /playlist (see Lau, column 6, lines 23 to 26). A directory, as would be commonly understood by a person of ordinary skill in the art of a file system in a computing device, is an entity in a file system that contains files or other directories, which is exactly how directories are used in claim 17 (***directories . . . in which the multimedia data files are contained***). Claim 17 (and claims 2, 5, and 9) makes it plain that a “directory” is distinct from a “file” by the choice of two distinct words, so does Lau in its specification².

Therefore, it cannot be sustainably asserted that displaying a play list -- which is a file in Lau -- discloses ***displaying directories in the storage device and in which the multimedia data files are contained, as different virtual data carriers*** -- which is plainly not so. Therefore, it is respectfully submitted that Lau like Lee does not disclose, or even suggest, the feature of ***displaying directories in the storage device and in which the multimedia data***

² Lau plainly refers to five top level directories: /MP3, /playlist, /playlist config, /microcontroller config and /OS, (see Lau, column 6, lines 19 to 22), each of which contains different types of files. Therefore, Lau refers to directories and files the same way as the present Application does.

files are contained, as different virtual data carriers as provided for in the context of the claimed subject matter.

Accordingly, for at least these reasons, it is respectfully submitted that claim 17 is allowable, as are its dependent claims 4, 6 to 8, and 10 to 16. Claims 2 (and its dependent claim 3, 5, and 9) include features like those of claim 17 and is therefore allowable for essentially the same reasons as claim 17.

As further regards the assertion that the independent claims provide no written interpretation, description or explanation as to what are considered different virtual data carriers, claim 17 (and claims 2, 5, and 9) plainly refers to *displaying directories* (within which multimedia data files are stored) *as different virtual data carriers*. Moreover, the specification (at page 1, lines 23 to 25) plainly discloses that “virtual data carriers are assigned to the individual directories in which the multimedia data files are located.” Therefore, it is respectfully submitted that “different virtual data carriers” are properly described by the specification -- especially to a person having ordinary skill in the art.

As to the Answer’s assertion that a “directory/playlist config containing files that include special configuration information for each play list” in Lau assertedly discloses different virtual data carriers (see Answer, page 4, lines 5 to 9, page 10, lines 6 to 10), it is respectfully submitted that the “/play config” directory containing files in Lau simply does not disclose different virtual data carriers as provided for in claim 17 (and claims 2, 5, and 9).

First, the “/play config” directory in Lau is a single directory containing files, so that the single “/play config” directory cannot disclose the plurality of *directories, as different virtual carriers*. Furthermore, the “/playlist config” directory in Lau contains files that include special configuration information for each play list (exemplified as to whether there should be a pause between tracks, whether text output should be enabled, whether random play should be enabled, the length of the gap between tracks, and information about repeating etc.) (see Lau, column 6, lines 29 to 35). This simply does not disclose (or even suggest) the feature of *directories in which the multimedia data files are contained, as different virtual data carriers*, as provided for in the context of claim 17 (and claims 2, 5, and 9), since files in the “/playlist config” directory are mere special track control information -- and not

multimedia data. Additionally, there is no indication in Lau that the singular “/playlist config” directory is (or even can be) displayed.

Therefore, it is respectfully submitted that the singular “/playlist config” directory in Lau does not disclose, or even suggest, the plurality of ***directories, as different virtual data carriers,*** as provided for in the context of the claimed subject matter.

Accordingly, for at least these additional reasons, it is respectfully submitted that claim 17 is allowable, as are its dependent claims 4, 6 to 8, and 10 to 16. Claims 2 (and its dependent claim 3), 5, and 9 include features like those of claim 17 and are therefore allowable for essentially the same reasons as claim 17.

Still further, as explained in the previously filed Appeal Brief, neither Lee nor Lau disclose nor suggest virtual data carriers as provided for in the context of claim 17. More specifically, Lee refers to a vehicle-based MP3 player, which “conventionally” displays titles or track numbers of the currently played music, and Lau refers to the downloading of music files to a vehicle sound system, in which play lists are employed for organizing the downloaded music files. As in Figs. 14 and 15 of the Lau reference, such play lists are physically created as part of the storage medium, and according to col. 6, lines 17 to 35, of the Lau reference, the hard disk drive exhibits these physically-created play lists as files that exist on the storage medium, (i.e., a directory/playlist for the files of play lists and a directory/MP3 for the MP3 files, in which the files of play lists contain the lists of MP3 files and links are provided between the playlists and MP3 files). Thus, Lau displays the playlists as files that actually exist as such on the storage medium.

In contrast, the presently claimed subject matter provides for the display of virtual data carriers which do not exist as such, but which are provided as part of the display so that a user can more easily search MP3 files in a format he or she may be more familiar with since the user may have previous operating CD changers.

Moreover, one skilled in the art would not identify a playlist as a data carrier, which, as exemplified in the present application, can include a CD, DVD or hard disk. Hence, the systems of Lee and Lau, whether taken alone or combined, do not disclose nor suggest all of the features and advantages of the presently claimed subject matter, with respect to a user

exploiting his or her knowledge about navigating CDs and/or CD changers. In this regard, the present application states, for example, on page 1, line 22 to page 2, line 1, that:

It is particularly advantageous that existing data structures are translated into an operating philosophy modeled on a CD changer. *In this context, virtual data carriers are assigned to the individual directories in which the multimedia data files are located, for example, CD 1 is assigned to directory 1, and the titles or numbers of the multimedia data files are assigned to the multimedia files contained therein. This results in markedly simplified operation which is very useful, particularly for an automobile driver, since he or she is not distracted by a complicated operation.*

Accordingly, for at least these reasons, it is respectfully submitted that claim 17 is allowable, as are its dependent claims 4, 6, 8 10 to 16. Claims 2 (and its dependent claim 3), 5, and 9 include features like those of claim 17 and are therefore allowable for essentially the same reasons as claim 17.

Claims 2 and 3

As further regards the rejections of claims 2 and 3, it is respectfully submitted that Lee and Lau, whether taken alone or combined, do not disclose or even suggest a processor that, together with an operation of an input apparatus, is capable of linking multimedia data files, located on a storage device, to at least one new directory, and that provides an option to store the multimedia data files once again, as provided for in the context of claim 2, as presented. Indeed, the MP3 files referred to by Lee and/or Lau cannot be arranged in a new directory by the user.

Accordingly, claim 2 and its dependent claim 3 are allowable for these further reasons.

As to the meaning of the “virtual data carrier” feature as recited in the context of the present claimed subject matter of the claimed subject matter, it is axiomatic that the terms of a claim are not interpreted in a vacuum, even though a pending claim may be “given the broadest reasonable interpretation consistent with the specification.” M.P.E.P. § 2111. The

law supports the eminently reasonable interpretation of the terms discussed herein based on the specification, as explained above. (See In re Weiss, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); In re Okuzawa, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation”; Board reversed; emphasis in original) (citing In re Royka, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part”; Board reversed; emphasis in original); and In re Rohrbacher, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)).

This applies to the “virtual data carrier” carrier features of each of the independent claims, as provided for in the context of the claimed subject matter and as disclosed as to the only embodiments of the specification and drawing, as explained herein and in the present application.

Accordingly, it is respectfully submitted that claims 2, 5 and 17 are allowable for the foregoing reasons, as are their respective dependent claims.

As further regards all of the obviousness rejections discussed herein, in rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, to

reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also suggest combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Moreover, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on, whether taken alone or combined, do not suggest in any way modifying or combining the references so as to provide the presently claimed subject matter for addressing the problems and/or providing the benefits of the “virtual data carrier” feature of the claimed subject matter as explained herein and in the specification.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, it is believed that there have been no such findings to establish that the features

discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference relied upon makes plain that it simply does not describe the features discussed above of the claims as now presented.

Thus, the proper evidence of obviousness must show why there is a suggestion as to the reference so as to provide the subject matter of the claimed subject matter and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent

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application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))).

In short, the Office bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

In short, claims 2 to 17 are allowable for all of the above reasons.

CONCLUSION

In view of the above, it is respectfully requested that the rejections of claims 2 to 17 be reversed, and that these claims be allowed as presented.

Dated: _____

2/8/008

Respectfully submitted,

By: _____

Gerard A. Messina
Gerard A. Messina
(Reg. No. 33,865)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

Reg. No. 33,865
Aaron C. DEDITCH